Remarks

Reconsideration of this Application is respectfully requested.

Claims 14 and 16 are pending in the application. Claims 3, 9, 11-13, 15 and 17 were previously cancelled without prejudice to or disclaimer of the subject matter therein. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. §§ 102 and 103

In the Advisory Action mailed October 5, 2010, the Examiner maintained the rejection of claims 14 and 16 under 35 U.S.C. § 102(b) as allegedly anticipated by or in the alternative under 35 U.S.C. § 103(a) as allegedly obvious over Asrar *et al.* (USPN 7,098,170). Applicants again traverse this rejection.

It is settled law that for process/method claims, "the 'material acted upon' must be given weight." *See Ex parte Zbornik and Peterson*, 109 U.S.P.Q. 508, 509 (BPAI 1956) ("Zbornik"). The Examiner continues to ignore this law in maintaining the rejections of the pending claims. The situation here is the same as in *Zbornik* where the Patent Office Board of Appeals found no merit in such a rejection. In *Zbornik*, the rejected claims were directed to a process of treating Air Sac Infection in fowl using para-aminobenzoic acid or its salts. The reference (Marshall) cited by the Examiner in rejecting the claims disclosed administering para-aminobenzoic acid to ducks in a trial of sulfonamide therapy of malaria. The Patent Office Board of Appeals found "***no merit*** in this rejection because in holding that Marshall substantially meets the claims ***the examiner is obviously giving no weight to the limitation in the claims that the medicated feed is administered to fowls infected with Air Sac Infection***. He thus ***fails to follow the long***

line of decisions in which it was held that ***in evaluating the patentability of process claims the 'material acted upon' must be given weight.***" *Id.* at 509 (emphasis added). The Board pointed out that "Marshall was not concerned with appellants' problem and he failed to even remotely suggest its solution." *Id.* at 508.

Similarly in the case at bar, in maintaining the rejections, the Examiner fails to give weight to the "material acted upon," *i.e.*, the seeds of soya bean plants subject to attack by phytopathogenic fungi. Like the Marshall reference in *Zbornik*, Asrar *et al.* does not disclose treating seeds of plants subject to attack by phytopathogenic fungi. Rather, Asrar *et al.* focuses solely on treating seeds of plants grown ***in the absence of pest pressure by fungal plant pathogens.*** Thus, Asrar *et al.* was not concerned with applicants' problem of treating seeds subject to attack by phytopathogenic fungi and fails to even remotely suggest its solution. Under *Zbornik*, this rejection remains improper.

The Examiner maintains that the soybean seeds in Asrar *et al.* are the same material as the presently claimed soybean seeds. To do so, instead of focusing on the differences in the material being acted upon, the Examiner erroneously focuses on the outcome of treating seeds. Soybean seeds subject to subsequent attack by phytopathogenic fungi (as presently claimed) are different than seeds that are ***never*** subject to any such attack (as disclosed in Asrar). Thus, the material acted upon in Asrar *et al.* is not the same as the material acted upon in the current claims. The law requires that the Examiner give weight to those differences and she has failed to do so. *See Zbornik*, 109 U.S.P.Q. at 509.

Moreover, not all plants grown in normal agricultural conditions are subject to subsequent attack by phytopathogenic fungi. Whether plants are susceptible to attack by

phytopathogenic fungi depends on weather conditions such as temperature and rainfall. *See, e.g.*, Goellner, K., *et al.*, *Mol. Plant Pathol. 11*:169-177 (2009); Del Ponte, E., *et al.*, *Phytopathology 96*:797-803 (2006); and Scherm, H., *et al.*, *Crop Prot. 28*:774-782 (2009) (cited herewith). Thus, the material acted upon in the current claims is different not only than the seeds disclosed in Asrar *et al.*, but also than seeds grown in regular agricultural conditions.

The Examiner's position on which the rejection is maintained, *i.e.*, that "Asrar et al. disclose all the limitations of the instant claims where soybean and seed are treated with fluquinconazole alone and/or combined with azoxystrobin which inherently protects the soybean from soybean rust" fails to recognize the differences between the seeds disclosed in Asrar *et al.* and the seeds as presently claimed and thus is improper in light of the holding of *Zbornik*. As such, Asrar *et al.* does not anticipate the present claims.

Nor can Asrar *et al.* render the present claims obvious. Obviousness cannot be based on unknown properties of a composition. *See In re Ehrreich*, 590 F.2d 902, 909 (C.C.P.A. 1979) ("The question in a § 103 case is what the references would collectively suggest to one of ordinary skill in the art."); *see also In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) ("That which may be inherent is not necessarily known . . . [and] [o]bviousness cannot be predicated on what is unknown."); *see also In re Adams*, 356 F.2d 998 (C.C.P.A. 1974).

Not only does Asrar *et al.* not disclose soy bean rust or even the fungal pathogen that causes it, but Asrar *et al.* focuses solely on increasing the yield and/or vigor of plants ***in the absence of pest pressure by fungal plant pathogens***. Because the claimed method was not taught by Asrar *et al.* and there is nothing in the Asrar *et al.* disclosure that

would have led one of ordinary skill in the art to practice the currently claimed methods, a *prima facie* case of obviousness has not been established.

In sum, Asrar *et al.* does not anticipate claims 14 and 16, and the Examiner has not established a *prima facie* case of obviousness of claims 14 and 16. Reconsideration and withdrawal of the rejections are earnestly solicited.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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